

IN RESPONSE TO THE OFFICE ACTION:

GENERAL REMARKS:

Applicant acknowledges the indication of allowability of claims 2, 3, 5, 6, and 10-11 with appreciation.

Certain of the claims have been amended to improve the format of means+function language contained therein. No substantive changes have been thereby affected.

REJECTION UNDER 35 U.S.C. § 112:

Claim 7 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 has been cancelled thereby obviating the rejection.

REJECTIONS UNDER 35 U.S.C. § 102:

Claims 1, 4, 7, 8, 9, and 12 were rejected under 35 U.S.C. §102(e)¹ as being anticipated by Rodriguez-Amaya *et al.* It is respectfully asserted that Claim 1 is not anticipated by Rodriguez-Amaya *et al.* ('626) because not all of the elements of claim 1 are present in Rodriguez-Amaya *et al.* ('626). This can be seen though the arrangement of the pump 21 in Rodriguez-Amaya *et al.* ('626) as compared to the pressuring means 11 for pressurizing the common rail in Applicant's invention. The pump 21 in Rodriguez-Amaya *et al.* ('626) is

¹ Examiner is reminded that for there to be anticipation under 35 U.S.C. §102, "each and every element" of the claimed invention must be found either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation."); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Crop. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990).

connected together with the piston pump 18 to supply the pressure. In Applicant's invention the pressure for the common rail is provided by the pressuring means 11, which is a separate pump for pressurizing the common rail. This is not disclosed in Rodriguez-Amaya *et al.* ('626). Further, the feed pump 21 in Rodriguez-Amaya *et al.* ('626) is a low pressure pump having an operational pressure on the order of five bars, typically. Applicants pressuring means 11 (pump) operates at much higher pressures since it, itself, must supply the pressure to common rail 10.

Claim 4 is not anticipated by Rodriguez-Amaya *et al.* ('626) because not all of the elements of claim 4 are present in Rodriguez-Amaya *et al.* ('626). Rodriguez-Amaya *et al.* ('626) does not disclose a pressuring means 11 for pressurizing the common rail and regulating the pressure of the fuel in the common rail. As described above, the feed pump 21 in Rodriguez-Amaya *et al.* ('626) does not perform these functions as claimed by Applicant. It is isolated via a control valve and the pressure is not enough alone to properly pressurize the common rail. The pressure that is provided in Applicant's common rail is high enough to overcome the spring 14 and open the nozzle 2, if permitted by control valve 9. Thus, Claim 4 is not anticipated by Rodriguez-Amaya *et al.* ('626). Likewise, Claims 7 and 8 are not anticipated by Rodriguez-Amaya *et al.* ('626) since they depend from Claim 4.

Claim 9 is not anticipated by Rodriguez-Amaya *et al.* ('626) because not all of the elements of Claim 9 are present in Rodriguez-Amaya *et al.* ('626). Rodriguez-Amaya *et al.* ('626) does not disclose that the pressure in the common rail is high enough to overcome the spring 14 and open the nozzle. The Applicant further asserts that the reasons stated in regards to Claims 1 and 4 also are relevant to show that Rodriguez-Amaya *et al.* ('626) does not teach all the elements of Claim 9. Thus, Claim 12 which depends from Claim 9 is allowable as well.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 13-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez-Amaya *et al.* Applicant asserts that they are allowable because they depend from allowable independent claim for the same reasons cited relative to claim 1, and further in view of the additional limitations contained therein. Therefore, Applicant requests that the Examiner reconsider and withdraw the above rejection of the claims in view of the following:

More specifically, the pump as recited in claim 13 is a variable displacement hydraulic pump. The Action asserts that because this is a type of pump known in the art, that a person skilled in the relevant art would be lead to substitute such a pump into the system of Rodriguez-Amaya *et a.l* ('626). The system of Rodriguez-Amaya *et a.l* ('626), however, does not use the pump in the same way as Applicant claims and thus the substitution would not yield the same result. Furthermore, the Action does not provide any suggestion, motivation or teaching to combine the elements.

Similar statements can be made regarding claim 14, which makes use of a fixed displacement hydraulic pump. The Action rejects claim 15, which is a hydraulic pump driven by the starter of engine, but there is no suggestion in the Action of such a pump much less combined with the system of Rodriguez-Amaya *et a.l* ('626). The Action also cites no suggestion in the prior art that would set the maximum value of the common rail to 600 bar.

In view of the above, Applicant submits that the requirement and burden of presenting a *prima facie* case of obviousness under 35 USC §103 has not been presented. Therefore Applicant requests reconsideration and withdrawal of the rejection of claims 13-16 under 35 USC §103 and that the claims be indicated as allowable in the next paper from the Office.

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The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Order No. 07589.0051.NPUS01.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,



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